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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/728,305	11/30/2000	Thomas A. Bohannon	ALTE00012	4910
34845	7590	09/21/2005	EXAMINER	
STEUBING AND MCGUINNESS & MANARAS LLP 125 NAGOG PARK ACTON, MA 01720			KANG, PAUL H	
			ART UNIT	PAPER NUMBER
			2141	

DATE MAILED: 09/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/728,305

Applicant(s)

BOHANNON ET AL.

Examiner

Paul H. Kang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-69 is/are pending in the application.
- 4a) Of the above claim(s) 5-69 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 6/21/2005

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1 and 3 are rejected under 35 U.S.C. 102(e) as being anticipated by Rune et al. (US Patent No. 6,304,913 and Rune hereinafter).

3. As per claim 1, Rune discloses a computer network, comprising:

a plurality of network appliances that optimize the performance of domains hosted on geographically distributed mirrored network sites, (See Column 1 Lines 54-67 & Column 2 Lines 1-24);

a client computer coupled to said plurality of network appliances (See Column 3 Lines 49-64); and

a network over which said network appliances and said client computer communicate (See Column 3 Lines 49-64);

wherein, in response to a connection request by the client to a mirrored network site, each network appliance associated with each mirrored network site responds to the connection request

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to allow the client to connect to a mirrored network site having an optimal response time to said connection request (A connection is established from a client to a mirror server having an optimal response time, i.e. the closest server or a server with the least amount of "hops" to traverse. See Column 1 Lines 54-67 & Column 2 Lines 1-24 and col. 6, lines 1-58).

4. As per claim 3, Rune teaches the claimed invention as described in claim(s) 1-2 above and furthermore discloses wherein said network appliance communicates with said client computer through a TCP protocol, (See Column 8 Lines 30-41).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rune as applied above, in view of Biliris et al., US Pat. No. 2002/0078233 A1.

6. As per claim 2, Rune discloses the invention substantially as claimed.

However, Rune does not explicitly teach wherein said network appliances communicate with each other through an authenticated protocol on top of a communications protocol.

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In the same field of endeavor, Biliris teaches a system and method wherein a network appliance communicates with each other through an authenticated protocol on top of a communications protocol, (See Paragraph 0151).

Therefore it would have been obvious to a person having ordinary skill in the art at the time of Applicant's invention to incorporate the use of an authenticated protocol as taught by Biliris, into the distributed data system of Rune, for the purpose of balancing security and simplicity.

As per claim 4, Rune-Biliris teach a computer network wherein said client computer runs a secure or insecure telnet session to display or modify the configuration of said network appliances (See Biliris, Paragraph(s) 0018-0019).

Response to Arguments

Applicant's arguments filed May 9, 2005 have been fully considered but they are not persuasive. These arguments were previously addressed in the advisory action of June 24, 2005. Because applicants have not submitted additional arguments in reply to the advisory action, the previous response is set forth below.

Applicants' arguments have been considered but do NOT place the application in condition for allowance because: Applicants' arguments filed May 9, 2005 are NOT deemed to be persuasive. The applicants argued in substance that:

1. “The Examiner, in this application, has introduced a new ground of rejection, namely a rejection of claims 1 and 3 under 35 U.S.C. §102(e) over Rune. Previously, these claims were rejected under 35 U.S.C. §103(a). While Applicants did amend the claim in the previous [O]ffice action, [Applicants’] amendments served the effect of narrowing the claim, rather than broadening it. Thus [Applicants’] amendments could in no way necessitate a broader scope of rejection than that previously placed on the claims... Applicants understand that the Examiner has taken over handling of this application from Examiner [Yussuf], and appreciates that the Examiner did not prepare the previous action. However, in the final rejection, the Examiner has failed to respond to any of Applicant’s arguments put forth in the response of 10/14/2004. Because Applicants have not [had] the ability to address the Examiner’s position with regard to the previous arguments, Applicants maintain that they have not received a full and fair hearing on this application; no clear issue has been [defined] because the Applicants are unable to discern the Examiner’s position with regard to their previous arguments.” See Remarks, pages 17-18.

In response to point 1) above, the examiner respectfully disagrees with the applicants. The introduction of a new grounds of rejection is deemed to be proper. While it is true that applicants’ amendments of 14 November 2004 narrowed the scope of certain limitations of the pending claims, the amendments also broadened the scope of other limitations found in the claims. Specifically, the limitation “a client computer capable running a session to display or change the configuration of said network appliances” found on lines 4-5 of claim 1, was

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amended to “a client computer coupled to said plurality of network appliances.” In the previous grounds of rejection, the Biliris reference was relied upon to teach the limitation as originally claimed. However, applicants’ amendment to broaden the scope of this limitation, effectively removing the limitation for which Biliris was relied upon, necessitated a change in the ground of rejection. Therefore, the new grounds of rejection is proper.

The applicants further argue that because the examiner did not respond to any of applicants’ previous arguments they “have not received a full and fair hearing on this application.” The examiner disagrees. The applicants, in their wholesale amendment of the claim language, necessitated a new grounds of rejection. Applicants’ amendments significantly changed the scope of the claimed invention. Thus, the new ground of rejection not only served to remove Biliris, but also served to remap the newly amended claim language to Rune. For instance, a passage of Rune previously not relied upon was cited for the newly added limitation “in response to a connection request by the client to a mirrored network site.” See Rune, col. 6, lines 1-58. Applicants’ previous arguments of 14 November 2004 failed to discuss this newly cited passage, and accordingly the Rune reference as newly relied upon. Therefore, applicants’ previous arguments were properly deemed to be moot in view of the new grounds of rejection.

However, in an attempt to clarify the issues for appeal, the examiner fully addresses below applicants’ newly raised arguments of June 7, 2005.

2. “Rune describes a method and Internet system that attempts to improve response times by automatically selecting for use a server located relatively close to a requesting host... Claim 1, in contrast, describes a system wherein a client selects a web site based

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on the optimal response time of a response to a client request to the web site. The present invention overcomes problems that are inherent in the systems of Rune, which are numerous and described on page 3 of Applicant's specification, and include that fact that web site assignment systems such as [Rune's] do not incorporate factors including the availability and loading of the web site." See Remarks, page 19.

As to point 2), the examiner respectfully disagrees. The applicants argue in substance that the "optimal response time" as claimed necessitates incorporation of factors including the availability and loading of the web site. Further, applicants allege that this meaning is somehow distinguishable from the teaching of Rune; specifically that "to connect to a mirrored network sites having an optimal response time" is distinguishable from connecting to "the closest server or the most appropriate server form a plurality of servers." Claim 1, line 8 and Rune, Abstract.

The applicants are reminded that during examination, the claims are given the broadest reasonable interpretation consistent with the specification and the prior art. *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000). The rationale for such interpretation is to reduce the possibility that the claims, once issued, are interpreted more broadly than justified, since applicant always has the opportunity to amend the claims during prosecution. *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969) (Claim 9 was directed to a process of analyzing data generated by mass spectrographic analysis of a gas. The process comprised selecting the data to be analyzed by subjecting the data to a mathematical manipulation. The examiner made rejections under 35 U.S.C. §101 and §102. In the 35 U.S.C. §102 rejection, the examiner explained that the claim was anticipated by a mental process

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augmented by pencil and paper markings. The court agreed that the claim was not limited to using a machine to carry out the process since the claim did not explicitly set forth the machine. The court explained that "reading a claim in light of the specification, to thereby interpret limitations explicitly recited in the claim, is a quite different thing from reading limitations of the specification into a claim,' to thereby narrow the scope of the claim by implicitly adding disclosed limitations which have no express basis in the claim." The court found that applicant was advocating the latter, i.e., the impermissible importation of subject matter from the specification into the claim.). See also *In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997). The broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach. *In re Cortright*, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999).

Here, when given the broadest reasonable interpretation consistent with the specification, "optimal response time" is no more than selecting from among a plurality of servers "the most appropriate server" as taught by Rune. Applicants' suggestion that "optimal response time" requires incorporation of factors including the availability and loading of the web site impermissibly reads limitations from the specification into the claims. Accordingly, applicants' arguments regarding "optimal response time" are not given weight as to the patentability of the claimed subject matter.

3. "There are several differences between Rune and the claimed invention. For example, in contrast to '...in response to a connection request by the client to a mirrored network site, *each network appliance* associated with each mirrored network site

responds to the connection request to allow the client to connect to a mirrored network sites having an... optimal response time to said connection request...' as recited in claim 1, Rune selects a site based on a hop count associated with IP addresses, the hop count being received from a neighboring router... Note a fundamental difference between the claimed invention and Rune; while a 'host' in Rune obtains information that is used in selecting a mirrored site from the closest router, in the claimed invention the 'client' receives responses 'from each mirrored site.' In Rune, the information stored in the routing table (hop count) does not reflect actual usage of resources at each of the mirrored sites." Remarks, page 22 (emphasis original).

As to point 3), applicants' characterization of Rune is incomplete. While it is true that Rune selects a site based on a hop count, Rune also teaches a system and method for "automatically selecting for use a server" wherein "in response to the second request, the router 105a determines the hop count for each IP address 116... and selects [based on the hop count] the closest alternative server..." See Rune, col. 6, lines 1-22. In Rune, the client (requesting host 152a) requests for connection to the closest alternative server or mirror server (the first and second requests). In response to this request, the network appliances, the routers, respond to enable connection to the closest server (by providing the hop count).

Additionally, as previously discussed, the claims are given their broadest reasonable interpretation consistent with the specification during prosecution. In the field of computer networks, the terms clients and servers are functional descriptors, i.e. a device is a client when it receives information, and a server when it transmits information. Therefore, applicants'

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arguments that the “host” of Rune cannot be read as the “client” of the claimed invention, is not persuasive. The “host” of Rune transmits a request to select a server on the network relatively close or one that is relatively appropriate. In this context, the “host” is acting as the “client.” As to applicants’ argument that hop count does not reflect actual usage of resources, applicants again attempt to read limitations from the specification in the claim language.

4. As to Biliris, applicants cite various sections of Biliris not relied upon by the examiner and argue that “...Biliris teaches that client association with different CNSs is controlled by the load-balancing switch in front of a chosen server farm. Such an arrangement is different than that of the claimed invention.” See Remarks, page 24.

As to point 4), applicants’ arguments regarding Biliris are in no way related to the reason for combining Biliris and Rune. Biliris was relied upon to show communication through an authenticated protocol on top of a communications protocol. Applicants do not address whether Biliris teaches the features for which it was relied upon. Instead it appears applicants are arguing that Biliris is nonanalogous art. It has been held that a prior art reference must either be in the field of applicants’ endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, both Rune and Biliris are in the field of applicants’ endeavor of computer network management and data routing. Therefore, the combination of the references is proper. It is noted that Biliris need not teach any claimed limitations except for which it was relied upon. Therefore,

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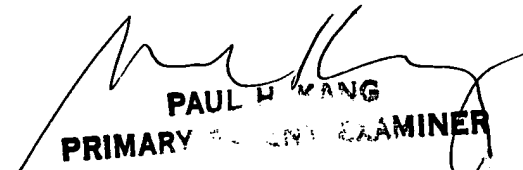
the examiner finds applicants' arguments regarding the load-balancing scheme taught in Biliris to be unpersuasive.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul H Kang whose telephone number is (571) 272-3882. The examiner can normally be reached on 9 hour flex. First Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on (571) 272-3880. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


PAUL H KANG
PRIMARY EXAMINER